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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/715,942

11/18/2003

Norman Castellani

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4458

7590

11/02/2004

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EXAMINER

PATEL, DHIRUBHAI R

ART UNIT

PAPER NUMBER

2831

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,942

Applicant(s)

CASTELLANI ET AL.

Examiner

DHIRU R PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The finality of the final rejection mailed on 08/06/2004 is hereby vacated. This office action replaces previously office action sent on 08/06/04 with a new statutory period. Any inconvenience to the Applicant is regretted.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103 (a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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2. Claims 1-28 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Whitehead (6,417,446).

Whitehead discloses:

Regarding claim 1, a poke-through fitting 10 (see fig 1, column 4 lines 35-40) of the type that is adapted to be supported in a circular opening 12 in a floor 14 of a building structure (see fig 2, entire column 2 and column 4 lines 35-67), the fitting comprising: an insert sized 20 (body, see figs 1-2, entire column 2 and column 5 lines 4-65) for insertion into the circular floor opening (see figs 1-2 and entire abstract as well as entire column 2); and two (separately) simplex power receptacles 98,99 having a respective housing and supported by the insert (see figs 5-7, column 8 lines 1-2), but fails to disclose two additional separately simplex power receptacles having a respective housing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the assembly of Whitehead with any number of separately simplex power receptacles, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. In addition, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In *re. Hutchison*, 69 USPQ 138. It is noted that the modified assembly of Whitehead meet the structural limitations.

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Regarding claim 2, the modified assembly of Whitehead disclose all the features of the claimed invention as shown above, including the simplex receptacles are configured to snap fit into a portion of the insert (see fig 1, and entire column 6).

Regarding claim 4, the modified assembly of Whitehead disclose all the features of the claimed invention as shown above, including at least two of the simplex power receptacles are wired in separate electrical circuits (see figs 5-7 and column 1 lines 54-57 and entire column 6). It is noted that the modified assembly of Whitehead meet the structural limitations.

Regarding claim 5, the modified assembly of Whitehead disclose all the features of the claimed invention as shown above, including a cover 136 assembly overlying the insert (see fig 3A), the cover assembly including access covers 150 for selectively covering and exposing the simplex power receptacles (see fig 3A and entire column 7).

Regarding claim 6, a poke-through fitting 10 (see fig 1, column 4 lines 35-40) of the type that is adapted to be supported in a circular opening 12 in a floor 14 of a building structure (see fig 2, entire column 2 and column 4 lines 35-67), the fitting comprising: an insert sized 20 (body, see figs 1-2, entire column 2 and column 5 lines 4-65) for insertion into the circular floor opening (see figs 1-2 and entire abstract as well as entire column 2); and two separately simplex power receptacles 98,99 with a respective housing and supported by the insert (see figs 5-7, column 8 lines 1-2),

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and four communication/data jacks 126, 127, 162 supported within the insert (please note that a wing 162 which allows the mounting of two additional data jacks, see fig 6, and entire column 7 and column 8), but fails to disclose two additional separately simplex power receptacles having a respective housing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the assembly of Whitehead with any number of separately simplex power receptacles , since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. In addition, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In *re. Hutchison*, 69 USPQ 138. It is noted that the modified assembly of Whitehead meet the structural limitations.

Regarding claim 7, the modified assembly of Whitehead disclose all the features of the claimed invention as shown above, including the simplex receptacles are configured to snap fit into a portion of the insert (see fig 1, and entire column 6).

Regarding claim 9, the modified assembly of Whitehead disclose all the features of the claimed invention as shown above, including at least two of the simplex power receptacles are wired in separate electrical circuits (see figs 5-7 and column 1 lines 54-57 and entire column 6). It is noted that the modified assembly of Whitehead meet the structural limitations.

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Regarding claim 10, the modified assembly of Whitehead disclose all the features of the claimed invention as shown above, including a cover 136 assembly overlying the insert (see fig 3A), the cover assembly including access covers 150 (see fig 3A and entire column 7) for selectively covering and exposing the simplex power receptacles (see fig 3A and entire column 7).

Regarding claim 11, a poke-through fitting 10 (see fig 1, column 4 lines 35-40) of the type that is adapted to be supported in a circular opening 12 in a floor 14 of a building structure (see fig 2, entire column 2 and column 4 lines 35-67), the fitting comprising: an insert sized 20 (body, see figs 1-2, entire column 2 and column 5 lines 4-65) for insertion into the circular floor opening (see figs 1-2 and entire abstract as well as entire column 2); the insert having an upper end adjacent to the floor and having a chamber defined therein which extends downwardly from the upper end (see fig 2), a cover 136 overlying the insert (see fig 3A), the cover having an upper surface, four communication/data jacks 126, 127, 162 mounted within the fitting such that the communication/data jacks do not extend upwardly beyond the upper surface of the cover (please note that a wing 162 which allows the mounting of two additional data jacks, see fig 6, and entire column 7 and column 8) and two separately simplex power receptacles 98,99 having a respective housing mounted within the fitting such that the simplex power receptacles do not extend upwardly beyond the upper surface of the cover (see fig 7, column 8 lines 1-2), but fails to disclose two additional separately simplex power receptacles having a respective housing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the assembly of Whitehead with any number of separate simplex power receptacles , since it has been held that mere duplication of the

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essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. In addition, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re. Hutchison*, 69 USPQ 138. It is noted that the modified assembly of Whitehead meet the structural limitations. Regarding claim 13, the modified assembly of Whitehead disclose all the features of the claimed invention as shown above, including at least two of the simplex power receptacles are wired in separate electrical circuits (see figs 5-7 and column 1 lines 54-57 and the entire column 6). It is noted that the modified assembly of Whitehead meet the structural limitations. Regarding claim 14, a flush poke-through wiring fitting 10 (see fig 1, column 4 lines 35-40) of the type that is adapted to be supported in a floor opening 12 in a floor 14 of a building structure (see fig 2, entire column 2 and column 4 lines 35-67), the poke-through fitting comprising: an insert sized 20 (body, see figs 1-2, entire column 2 and column 5 lines 4-65) for insertion into the circular floor opening (see figs 1-2 and entire abstract); a cover 136 overlying the insert (see fig 3A), the cover having an upper surface; and two simplex power receptacles 98,99 having a respective housing and mounted within the fitting in a protected fashion such that the power receptacles do not extend upwardly beyond the upper surface of the cover (see fig 2, column 8 lines 1-2), but fails to disclose two additional simplex power receptacles having a respective housing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the assembly of Whitehead with any number of separate simplex power receptacles , since it has been held that mere

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duplication of the essential working parts of a device involves only routine skill in the art. St.

Regis Paper Co. v. Bemis Co., 193 USPQ 8.

In addition, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re. Hutchison, 69 USPQ 138. It is noted that the modified assembly of Whitehead meet the structural limitations.

Regarding claim 16, a poke-through fitting 10 (see fig 1, column 4 lines 35-40) of the type that is adapted to be supported in a circular opening 12 in a floor 14 of a building structure (see fig 2, entire column 2 and column 4 lines 35-67), the fitting comprising: four communication/data jacks 126, 127, 162 mounted within the fitting (please note that a wing 162 which allows the mounting of two additional data jacks, see fig 6, and entire column 7 and column 8), the communication/data jacks being arranged in a longitudinal row (see fig 6); first and second simplex electrical receptacles with a respective housing disposed on a first lateral side of the communication/data jack (see fig 6); but fails to disclose third and fourth simplex receptacles disposed on a second lateral side of the communication data jacks, It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the assembly of Whitehead with any number of separate simplex power receptacles , since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

In addition, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not

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constitute a limitation in any patentable sense. In re. Hutchison, 69 USPQ 138. It is noted that the modified assembly of Whitehead meet the structural limitations.

Regarding claim 17, the modified assembly of Whitehead disclose all the features of the claimed invention as shown above, including the first pair of the simplex power receptacles are wired in separate electrical circuits from the second pair of simplex receptacles (see figs 5-7 and column 1 lines 54-57 and the entire column 6). It is noted that the modified assembly of Whitehead meet the structural limitations.

Assembly of the device of Whitehead comprises method step of:

Regarding claim 18, a method of delivering flush poke-through wiring fitting 10 (see fig 1, column 4 lines 35-40) that is adapted to be supported in a floor opening 12 in a floor 14 of a building structure (see fig 2, entire column 2 and column 4 lines 35-67), the method comprising: providing a cover 146 that overlies the fitting and has an upper surface (see fig 2); mounting four communication/data jacks 126, 127, 162 within the fitting such that the communication/data jacks do not extend upwardly beyond the upper surface of the cover (please note that a wing 162 which allows the mounting of two additional data jacks, see fig 6, and entire column 7 and column 8); mounting two separately formed simplex power receptacles 98, 99 having respective housing within the fitting such that the simplex power receptacles do not extend upwardly beyond the upper surface of the cover (see fig 3B), but fails to disclose two additional communication/data jacks and two separately formed simplex power receptacles. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the assembly of Whitehead with any number of separate simplex power receptacles , since it has been held that mere duplication of the

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essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 20, further comprising wiring at least two of the simplex power receptacles in separate electrical circuits (see column 2 lines 1-7). It is noted that the modified assembly of Whitehead meet the structural limitations.

Regarding claim 21, a method for providing a poke-through fitting 10 (see fig1, column 4 lines 35-40) of the type that is adapted to be supported in a circular opening 12 in a floor 14 of a building structure (see fig 2, entire column 2 and column 4 lines 35-67), the method comprising: providing an insert sized 20 (see figs 1 and 6, entire column 2, column 5 lines 4-65) for insertion into the circular floor opening (see figs 1-2, entire abstract as well as entire column 2); and mounting two separately simplex power receptacles 98,99 having a respective housing within said insert (see figs 1 and 6). But fails to disclose two additions simplex power receptacles having a respective housing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the assembly of Whitehead with any number of separate simplex power receptacles , since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. In addition, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re. Hutchison, 69 USPQ 138. It is noted that the modified assembly of Whitehead meet the structural limitations.

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Regarding claim 22, the modified assembly of Whitehead disclose all the features of the claimed invention as shown above, including wherein the simplex receptacles are configured to snap fit into a portion of the insert (see fig 6).

Regarding claim 24, the modified assembly of Whitehead disclose all the features of the claimed invention as shown above, including wiring at least two of the simplex receptacles in separate electrical circuits (see fig 7 and entire column 6). It is noted that the modified assembly of Whitehead meet the structural limitations.

Regarding claim 25, the modified assembly of Whitehead disclose all the features of the claimed invention as shown above, including a cover 136 assembly including access covers 150 (see fig 3A and entire column 7) for selectively covering and exposing the simplex power receptacles (see fig 3A and entire column 7).It is noted that the modified assembly of Whitehead meet the structural limitations.

Regarding claim 26, a method for providing a poke-through fitting 10 (see fig 1, column 4 lines 35-40) of the type that is adapted to be supported in a circular opening 12 in a floor 14 of a building structure (see fig 2, entire column 2 and column 4 lines 35-67), the method comprising: providing an insert sized 20 (body, see figs 1 and 6, entire column 2, column 5 lines 4-65) for insertion into the circular floor opening (see fig 2); mounting two separately formed simplex power receptacles 98,99 having a respective housing within the insert; and mounting four communication/data jacks 126,127, 162 within the insert (please note that a wing 162 which allows the mounting of two additional data jacks, see fig 6, and entire column 7 and column 8). But fails to disclose two additional simplex power receptacles having a respective housing.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the assembly of Whitehead with any number of separate simplex power receptacles , since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. In addition, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re. Hutchison*, 69 USPQ 138. It is noted that the modified assembly of Whitehead meet the structural limitations.

Regarding claim 27, a method for providing a poke-through wiring fitting 10 (see fig 1, column 4 lines 35-40) of the type that is adapted to be supported in a circular floor opening 12 in a floor 14 of a building structure (see fig 2, entire column 2 and column 4 lines 35-67), the method comprising: mounting four communication/data jacks 126, 127, 162 (please note that a wing 162 which allows the mounting of two additional data jacks, see fig 6, and entire column 7 and column 8), the communication/data jacks being arranged in a longitudinal row; mounting first and second simplex power receptacles 98 , 99 on a first lateral side of the communication/data jack; the first and second simplex power receptacles 98, 99 having a respective housing, but fails to disclose the third and fourth simplex power receptacles with a respective housing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the assembly of Whitehead with any number of separate simplex power receptacles ,

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since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. In addition, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re. Hutchison*, 69 USPQ 138. It is noted that the modified assembly of Whitehead meet the structural limitations. It is noted that the modified assembly of Whitehead meet the structural limitations.

Regarding claim 28, the modified assembly of Whitehead disclose all the features of the claimed invention as shown above, including wiring the first pair of simplex power receptacles 18 are in a separate electrical circuit from the second pair of simplex receptacles (see fig 7 and entire column 6).

Regarding claims 3,8,12,15, 19 and 23, the modified assembly of Whitehead disclose all the features of the claimed invention as shown above, including a fire stopping material disposed in the insert (see column 2 lines 50-52, and column 8 lines 53-67 and column 9 lines 1-6).

With respect to claims 12, 15 and 19, the floor opening formed in the floor and with the poke-through wiring fitting supported in the floor opening, is substantially the same as the fire rating of the floor without the floor opening formed in the floor .

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Conclusion

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Response to Arguments

4. Applicant's arguments with respect to claims 1-28 have been considered , and to satisfy the Applicant's arguments as well as the claims limitations, a new final office action being issued using the same reference, claims 18-20 now rejected using 103 rejection due to claim 18 being amended to include a respective housing for receptacle .

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Contact information

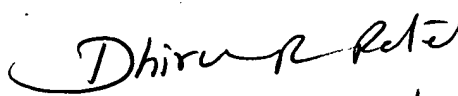
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dhiru Patel whose telephone number is 571-272-1983. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Dhiru Patel
Primary Examiner
Group Art Unit 2831
October 30, 2004


DHIRU R. PATEL
PRIMARY EXAMINER
10/30/04.